

REMARKS

Responsive to the Office Action Applicants have amended independent claims 1, 17, 29 and 30 to more clearly and particularly characterize the method of the present invention as being suitable for making an article with a printed image, the article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad, or keyfob. Such articles are defined as having a cover part formed of a flexible and indentable material as set forth in independent claims 1, 17, 29 and 30 pursuant to this amendment.

As mentioned previously, business accessory articles of the type characterized by claims 1, 17, 29 and 30, as now presented, are normally manufactured in relatively large quantities upon receipt of orders placed by customers who wish to have a particular graphic image placed on the article. A manufacturer of such articles needs to develop a fast and cost efficient process for applying graphic images on such articles, since they are often produced for distribution at tradeshows and conventions, for commemorations of important events, or for other group gatherings. Applicants verily believe that the method set forth in Claims 1, 17, 29 and 30 is, in each instance, patentably distinct and that one would not look to the art of paper label making, or the art of coating compositions which enhance the printability of plastic surfaces, or the art of making embossed or ornamented floor or wall tiles, or the art of marking housings of appliances that are formed of meltable plastic materials, or the art of making identification cards, or the art of placing security elements on bank notes, or the art of making intaglio printing plates as set forth in the references of record in this application. Applicants respectfully submit that the large number of references of somewhat diverse subject matter which have been combined to reject the claims in this application indicates that the method of making an article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob having a cover part formed of a flexible and indentable material is not an

obvious process according to steps set forth in Claims 1, 17, 29 and 30 and the claims dependent on Claims 1 and 17, respectively.

In the Office Action the Examiner rejected Claims 1, 2, 8 through 17, 20 through 24, and 26 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,974,2302 Jenkins in view of US 5,891,552 to Lu et al, US 6,277,228 to Fabrikant et al, US 4,778,547 to Becker et al, and US 5,380,044 to Aitkens et al. The Jenkins reference is directed to a label making method for producing labels for attachment to file folders. Data in respect to various labels is entered into a computer database and includes typed information in color coded graphics. The labels are printed on adhesive sheets which are laminated with a clear cover sheet, then diecut and applied to the edges of file folders. Jenkins is not concerned with the manufacture of business accessory articles, but only with making labels for attachment to paper file folders, which labels may be generated by a computer and printer and diecut to their final shape.

With regard to the Lu et al patent, this reference describes a process for thermal transfer printing on plastic films, the films being coated with a composition by being contacted with a thermographic ribbon and a dye layer is transferred from the ribbon to the film for making plastic labels. Modifying the process of Jenkins et al to provide plastic labels as suggested by Lu et al would not suggest to one of ordinary skill in the art of making business accessory articles with a graphic image on a debossed or indented portion of a cover part of such an article according to Claims 1 or 17.

Looking still further at the large combination of references cited in rejecting Claim 1, the Becker et al reference is directed to a process for making floor or wall tiles by laminating and embossing a resinous top layer adhered to a base or substrate. There is clearly no motivation to combine the teaching of Becker et al, a reference directed to making floor or wall tiles, with Lu et al, a reference directed to a method for making plastic labels for outdoor use and with Jenkins et al, a reference which is directed to a process for

making labels with printed information for attachment to file folders, in a way which would lead one to make an article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob having a cover part formed of a flexible and indentable material and including the steps of Claim 1 which include bonding an image sheet to the cover part member by pressing and applying RF energy and debossing the member to form an indentation while bonding the image sheet at the indentation. None of the references are directed to a method of making a business accessory article, as set forth in Claim 1, nor do they suggest the steps set forth above for such a process.

The Examiner has further combined the teaching of US Patent 6,277,228 to Fabrikant et al with the references previously discussed. The Fabrikant et al reference is directed to a method of affixing a permanent identification mark or indicia on a plastic material, such as the housing of an appliance, wherein the housing is melted by application of a "branding" tool. The branding tool is not unlike a typical soldering tool and is heated to a temperature sufficient to melt the plastic material of an appliance housing, for example. A label of a desired size is attached to the appliance housing and, according to Fabrikant et al, becomes soft, stretches, melts or disintegrates when heated to a predetermined temperature by a heating device connected to the branding tool and having desired indicia embossed thereon. The heat from the indicia on the branding tool of Fabrikant et al stretches, melts or disintegrates the label to form an identification on the housing even if the label is forcibly removed from the housing or substrate, thus leaving a permanent indicia on the substrate. Stretching, melting or disintegrating the image sheet of Applicants' invention, as suggested by Fabrikant et al, would be completely opposite the result desired according to the method of Claims 1 and 17. As with the references mentioned earlier, there is no suggestion in Fabrikant et al which would motivate one, when taking Jenkins, Lu et al and Becker et al, alone or in combination, to provide an image sheet with a printed image on

one side and then contacting the image sheet on the opposite side with a member as set forth in Claim 1 and bonding the image sheet by pressing the image sheet and applying RF energy to adhere the image sheet to the member while at the same time debossing the member to form an indentation in the member for the purpose of applying and preserving a graphic image.

With regard to the rejection of Claims 1, 2, 8 through 17, 20 through 24 and 26, the teaching of Aitkens, et al taken together with Jenkins, Lu et al, Becker et al and Fabrikant et al does not make obvious the combination of steps set forth in the method of Claim 1 together with Claims 2 and 8 through 16 dependent thereon, nor Claim 17 and dependent Claims 20 through 24 and 26. With regard to Aitkens et al, this patent describes a method of printing desired information in reverse on a transparent vinyl sheet which is then fused to a plastic substrate to seal the printed ink on the sheet between the vinyl and the plastic substrate and allow the ink to leach into and permanently mark the substrate. Again, the art of making identification cards, floor tiles, marking plastic appliance housings, and making labels for file folders are so diverse and removed from the art of making a business accessory article as set forth in Claims 1 and 17 that Applicants verily believe the combined teaching of these references does not make obvious the method for making a business accessory article as set forth in these claims in that there is no motivation to bond image sheets in contact with members formed of flexible and indentable material which will form a cover part of an article of the type set forth in Claim 1 together with debossing the member to which the image sheet is bonded while the bonding of the image sheet is carried out. In at least these respects Claim 1 is believed to clearly distinguish in an unobvious and patentable sense over the combined teaching of the five references cited in rejecting this claim under 35 U.S.C. 103(a) and reconsideration for allowance of Claim 1 is respectfully requested.

Claims 2 and 8 through 16 remain dependent on Claim 1 and are believed to be patentably distinct at least for the reasons set forth above in support of the patentability of Claim 1.

With regard to Claim 11, in particular, the Examiner states that one skilled in the art would appreciate treating the plastic film prior to coating to allow better adhesion of the coating to the film and the treatment which would provide a textured surface is well known and conventional. However, the references of record do not disclose or suggest providing a textured surface of an image sheet prior to applying a coating thereto.

Applicants request reconsideration for allowance of Claim 17 and the claims dependent thereon for the reasons set forth above in support of the patentability of Claim 1. Claim 17 has also been amended to recite a method of making an article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob having a cover part formed of a flexible and indentable material by bonding at least one image sheet to a member forming part of the cover part with a debossing die and applying RF energy to bond the image sheet to the member at an indentation formed in the member.

None of the references cited in rejecting Claim 17, except Fabrikant et al, are indicated to be directed to a method which results in an indentation in a member to which a graphic image is to be applied. However, Fabrikant et al, which is directed to a method for placing an identification mark on an appliance housing with a branding iron type of device, is clearly not concerned with displaying a graphic image since the device of Fabrikant et al includes a desired indicia thereon which is to be "branded" into a plastic appliance housing. Fabrikant et al suggests that the "label" which has already been attached to a surface of the appliance housing is to be stretched, melted or disintegrated. Following the teaching of Fabrikant et al would result in destruction of the graphic image in accordance with the method of Applicants' invention as set forth in Claim 17. Moreover, Applicants' invention clearly does not rely on indicia formed on a debossing die, but indicia or images formed on an image sheet, the integrity of which is to be retained after the bonding and debossing takes place. Accordingly, modifying the diverse processes suggested by Jenkins, Lu et al, and Becker et al, as suggested by Fabrikant et al, would not make obvious to

one of ordinary skill in the art of making articles such as set forth in Claim 17 and reconsideration for allowance of Claim 17 is respectfully requested.

Claims 20 through 24 and 26, remaining dependent on Claim 17, have also been rejected under 35 U.S.C. 103(a) over the combination of references cited in rejecting Claim 17. Reconsideration for allowance of these claims is requested for the reasons set forth above in support of the patentability of Claim 17. Still further, with regard to Claim 20, the Examiner has rejected this claim stating that one skilled in the art would appreciate using a guide device to aid in properly placing an image sheet onto a folder or substrate. However, the Examiner has not cited any prior art which discloses or suggests the overall combination of features of Claims 17 and 20.

With regard to Claim 21, the Examiner has also not cited any prior art, but states that it would be logical to one skilled in the art to use a light beam for accurately placing an image sheet on a substrate. Again, the Examiner has not cited any prior art which discloses or suggests the overall combination of features of Claims 17 and 21.

In the Office Action the examiner rejected Claim 18 under 35 U.S.C. 103(a) over Jenkins, Lu et al, Fabrikant et al, Becker et al, Aitkens et al and further in view of US Patent 5,817,205 to Kaule. The Examiner has relied further on a reference from an art unrelated to a method for making an article of the type set forth in Claim 17. The Kaule reference discloses a method and apparatus for making bank notes and the like which have applied to a surface of such a document a security element such as a hologram, interference element, liquid crystal polymer or the like. The Examiner refers to column 9, lines 25 through 46 together with drawing Figures 2 and 3, stating that it would be obvious to one skilled in the art to emboss or deboss a substrate to provide an indentation forming a guiding and positioning surface to properly place an image sheet on the surface. Kaule suggests providing smooth and finished surfaces on a document for application of a bonding agent thereto followed by subsequent transfer of an endless hologram to "a

glazed stripe or stripes" formed on the document surface. Positioning "means" is described, but not shown, that ensures that a "transfer band" comes to lie in exact registration with the glazed stripes. However, positioning equipment is not what is being claimed in the combination of Claims 17 and 18. It is the formation of an indentation itself which provides a guide for locating the image sheet on the member prior to placing the image sheet in contact with the member. This is not what is suggested by the Kaule reference. Accordingly, the overall combination of steps set forth in Claims 17 and 18 is not believed to be made obvious by the combined teaching of the six references cited by the Examiner and reconsideration for allowance of Claim 18 is also requested.

With regard to Claim 19, Applicants respectfully submit that the combination of steps which include placing at least one image sheet on a debossing die and placing the member over the image sheet to bond the image sheet to the member at an indentation formed in the member is not made obvious by the prior art. In the Office Action the Examiner rejected Claim 19 over the combined teaching of Jenkins, Lu et al, Fabrikant et al, Becker et al, Aitkens et al and US Patent 3,301,703 to Owen. It is noted that the Owen reference is directed to the production of intaglio printing plates which bear embossed type characters thereon. Owen discloses a punch and die set for forming a print plate (10) with an embossed type character such as the letter "T", and wherein a strip of easily deformable plastic is interposed the punch and the printing plate blank to form a "skintight lining". However, there is no disclosure or suggestion in Owen of a process of making an article by placing an image sheet on a debossing die and placing a flexible and indentable member over the image sheet prior to bonding the image sheet to the member with RF energy at an indentation formed in the member in accordance with the combination of steps of Claims 17 and 19. Moreover, the tortuous path that the Applicants would be required to take to look in six diverse fields of endeavor and then combine the references, six total, to provide the invention set forth in Claim 19 is not believed

to be an obvious thing to do and reconsideration for allowance of Claim 19 is respectfully requested.

Reconsideration for allowance of Claims 25 and 26, both dependent on Claim 17, is requested for the reasons set forth above in support of the patentability of Claim 17.

Reconsideration for allowance of Claim 29 is requested. Claim 29 has been amended along the lines of the amendments to Claims 1 and 17 and Claim 29 has been further amended to recite that the image sheet is placed in contact with the member forming a cover part of the article within an indentation formed on the member by a debossing operation.

In the Office Action the Examiner rejected Claim 29 under 35 U.S.C. 103(a) over Jenkins in view of Lu et al, Fabrikant et al, Becker et al and Kaule. As mentioned previously, Applicants verily believe that the large number of references cited, each being from somewhat diverse, unrelated fields of endeavor, do not make obvious the invention claimed in this application, including the combination of steps recited in Claim 29. Jenkins is directed to making labels for paper file folders. Lu et al is directed to a process for thermal transfer printing on plastic films to form weatherproof labels. Fabrikant et al is directed to a device and method for, essentially, "branding" plastic appliance housings by placing a label on the housing and forcibly melting the housing with a branding iron type device which stretches, melts or disintegrates the label. Still further, as previously mentioned Becker et al is directed to a process for ornamenting floor or wall tiles and, lastly, Kaule is directed to a method for placing an identifying band on valuable documents which have a glazed stripe or stripes to which the bands are applied.

Applicants respectfully submit one of ordinary skill in the art of making articles as set forth in Claim 29, which include cover parts formed of a flexible and indentable material, would not look to the art of applying security elements to valuable documents to protect against forgery, or the art of ornamenting floor or wall tiles, or the art of marking indicia on appliance housings, or the art of making

plastic films, or the art of making paper labels for file folders and attempt to combine the steps in all these diverse fields to arrive at a process for making an article as set forth in Claim 29 wherein a member formed to be part of a cover part of the part of article is debossed to form an indentation and then an image sheet is placed in contact with the member within the indentation and then bonded to the member within the indentation to adhere the image sheet to the member. The process disclosed and suggested by Fabrikant et al is clearly not the intended result of the process set forth in Claim 29 and modifying the processes of Jenkins, Lu et al, Becker et al or Kaule would not provide the invention of Claim 29. Moreover, Kaule clearly does not disclose or suggest a debossing step as a way of identifying the place to apply an image sheet to a member forming a cover part of a business accessory article. Kaule prepares the indentations in the document material to allow better adhesion of the authentication element and the authentication element is located within the stripe or stripes by "positioning means", not shown in the drawings of Kaule, to ensure that the transfer band comes to lie in exact registration with the glazed stripes on the document. The method of Kaule does not require the indentation to locate the "transfer band" since this is done by some type of "positioning means" not disclosed otherwise in Kaule. Accordingly, the overall combination of steps set forth in Claim 29 is not suggested by the references taken alone or in combination.

Applicants respectfully submit that it is improper for the Examiner to look for each element in a claim in diverse arts and wherein, within the cited references themselves, there is no suggestion or motivation to combine steps from five different references, none of which are directed to a method of making an article as set forth in Claim 29. Applicants further submit that it is impermissible to combine references which do not suggest the overall combination. Essentially all patentable inventions are made up of steps or elements which can be found somewhere in the prior art when the subject matter of the prior art is opened up to include essentially any field of endeavor.

In the Office Action the Examiner rejected Claim 30 under 35 U.S.C. 103(a) as being unpatentable over Jenkins in view of Lu et al, Fabrikant et al, Becker et al, and Owen. Claim 30 recites a method for making an article having a cover part formed of a flexible and indentable material by providing a member formed of said flexible and indentable material and comprising at least a portion of the cover part and further including the steps of placing an image sheet on a debossing die and placing the member in engagement with the image sheet and bonding the image sheet to the member by pressing the image sheet and the member together while supported on the debossing die and also while indenting the member.

The Examiner has combined Jenkins, Lu et al, Fabrikant et al, and Becker in the same manner as combined for the rejection of Claim 29. However, the examiner has substituted the Owen reference for the Kaule reference in rejecting Claim 30. As pointed out previously, it is noted that the Owen reference is directed to a process for making a printing plate for intaglio printing, the indentation formed in the printing plate includes a pigmented coating which may be applied by a thin plastic film laid over a punch member of a punch and die set which will form the characters on the printing plate whereby the pigmented coating is then applied to the printing plate within the recess of the so formed character. There is clearly no suggestion in Owen to modify a label making process or a tile making process. More importantly, there is no suggestion in Owen to make a business accessory article of the type recited in Claim 30 by placing an image sheet on a debossing die and then placing a member forming a portion of a cover part of the article in engagement with the image sheet and then bonding the image sheet to the member by pressing the image sheet and the member together while supported on the debossing die and while indenting the member, as required by Claim 30. As with the other rejections discussed above the Examiner has pulled together five references of diverse methods and diverse arts in making the rejection under the obviousness test, which rejection

is believed to be improper. Reconsideration for allowance of Claim 30, as amended, is respectfully requested.

Applicants have made a further diligent effort to advance the prosecution of this application by amending the independent claims and by pointing out with particularity herein how the claims now presented in this application are believed to be directed to a non-obvious advance in the art of making business accessory articles comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob having a cover part formed of a flexible and indentable material. Reconsideration for allowance of Claims 1, 2, 8 through 26, 29 and 30, as now presented, is respectfully solicited.

Respectfully submitted,

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MARKED UP AMENDED CLAIMS  
(AMENDMENT B)

1. (Twice Amended) A method of making an article with a printed image thereon, said article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob having a cover part formed of a flexible and indentable material, said method comprising the steps of:

providing a member formed of [a] said flexible and indentable material and comprising at least a portion of [a] said cover part of said article;

providing an image sheet of a flexible material to be bonded to said member;

printing an image on said image sheet on a first side thereof;

placing said image sheet in contact with said member at a second and opposite side of said image sheet;

bonding said image sheet to said member by pressing said image sheet to said member and applying RF energy to adhere said image sheet to said member; and

debossing said member to form an indentation therein while bonding said image sheet to said member in said indentation.

17. (Twice Amended) A method of making an article with a printed image thereon, said article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob having a cover part formed of a flexible and indentable material, said method comprising the steps of:

providing a member formed of [a] said flexible and indentable material and comprising at least a portion of [a] said cover part of said article;

providing a sheet of flexible plastic material adapted to be receptive to multiple printed images on one side of said sheet of flexible plastic material;

transferring an image to be applied to said sheet of flexible plastic material to a processor;

causing said processor to control a printer for printing multiple images on said sheet of flexible plastic material;

cutting multiple image sheets from said sheet of flexible plastic material along predetermined contours of said images, respectively;

placing at least one of said image sheets in contact with said member; and

bonding said at least one image sheet to said member by engaging said at least one image sheet with a debossing die and applying RF energy to bond said at least one image sheet to said member at an indentation formed in said member.

18. (Amended) The method set forth in claim 17 including the step of:

debossing said member to form [an] said indentation therein to provide a guide for locating said at least one image sheet on said member prior to placing said at least one image sheet in contact with said member.

24. (Amended) The method set forth in claim 17 including the step of:

debossing said member to form [an] said indentation therein while bonding said at least one image sheet to said member.

29. (Amended) A method of making an article with a printed image thereon, said article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, or keyfob having a cover part formed of a flexible and indentable material, said method comprising the steps of:

providing a member formed of [a] said flexible and indentable material and comprising at least a portion of [a] said cover part of said article;

providing an image sheet of a flexible material to be bonded to said member;

printing an image on said image sheet on a first side thereof;

debossing said member to form an indentation therein;

placing a second and opposite side of said image sheet in contact with said member [at] within said indentation; and

bonding said image sheet to said member [at] within said indentation by pressing said image sheet to said member and applying RF energy to adhere said image sheet to said member.

30. (Amended) A method of making an article with a printed image thereon, said article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, or keyfob having a cover part formed of a flexible and indentable material, said method comprising the steps of:

providing a member formed of [a] said flexible and indentable material and comprising at least a portion of [a] said cover part of said article;

providing an image sheet of a flexible material to be bonded to said member;

printing an image on said image sheet on a first side thereof;

providing a debossing die and placing said image sheet on said debossing die

placing said member in engagement with said image sheet at a second and opposite side of said image sheet; and

bonding said image sheet to said member by pressing said image sheet and said member together while supported on said debossing die and applying RF energy to adhere said image sheet to said member while indenting said member.